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Amdt. dated November 17, 2005

Docket No. 98005.00012

### Remarks

Claims 1, 20, 29, 32-34, 41 and 42 have been amended, new claims 43-46 have been added, and therefore claims 1-34 and 40-46 are currently pending in this application. In view of the above amendments and the following remarks, it is respectfully submitted that these claims are allowable.

Claims 1 - 3 and 11 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Michelson (U.S. Patent No. 4,985,019); Claims 29 and 32 - 33 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Smolen (U.S. Patent No. 4,015,034); Claims 34 and 41 - 42 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Bedford, Jr. (U.S. Patent No. 4,951,595); Claims 1 and 40 stand rejected under 35 U.S.C. 102 (b) as being anticipated by Riordan (U.S. Patent No. 6,063,225); Claims 29-31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Riordan in view of Bedford, Jr.; Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Michelson; and Claims 1 - 7, 11, 12, and 14 - 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson II (U.S. Patent Publication No. 2003/0182815). The Examiner's grounds for rejection are hereinafter traversed, and reconsideration is respectfully requested, particularly in view of the clarifying amendments to the claims.

Michelson does not teach or suggest a marker for identifying or measuring details of an image provided on a light transmitting substrate on the which the marker is overlaid, much less a substrate having an adhesive backing releasably engageable with the light transmitting substrate at an engaged position overlying at least a portion of the image, as recited in amended independent claim 1. Nor does Michelson teach or suggest such a marker further having at least one portion located laterally on the substrate with respect to the adhesive backing that is substantially transparent, that overlies at least a portion of the image in the engaged position with at least a portion of the underlying image viewable therethrough, and that has indicia viewable with reference to at least a portion of the underlying image through the substantially transparent portion for identifying or measuring details of the underlying image, as further recited in amended independent claim 1. To the contrary, Michelson's teachings are limited to an x-ray marker that is attached to a person's skin for guiding a needle through the marker and into the skin. There is no teaching or suggestion in Michelson of an adhesive backing releasably engageable with a light transmitting substrate. Further, there is no teach or suggestion in

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Michelson of a substantially transparent portion, much less one that is located laterally on the marker with respect to the adhesive backing and overlying at least a portion of the image of the light transmitting substrate in the engaged position such that at least a portion of the underlying image is visible therethrough, as recited in amended independent claim 1. In stark contrast to the presently claimed invention, Michelson's marker is opaque with a radiopaque grid 18. There is no teaching or suggestion to provide Michelson with a visibly transparent portion, nor would there be any need or motivation to do so.

The recitations in the preambles of the amended independent claims 1 and 42 are not merely the recitation of an "intended use" that are without patentable significance as suggested by the Examiner. First, the recitations in the preambles are structural limitations that must be fully considered in distinguishing the invention over the cited prior art. Second, these limitations in the preambles further define the limitations in the bodies of the claims tied thereto. These limitations in the preambles and bodies of the claims are not mere recitations of "intended use" as asserted by the Examiner, but rather are clear structural limitations that must be fully considered in distinguishing the claimed invention over the cited prior art. See M.P.E.P. § 2111.02 ("Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.") (Emphasis added). See also Seachange Int'l, Inc. v. C-Cor Inc., No. 04-1375, 04-1498, 2005 WL 1523382 at 13 (Federal Circuit June 29, 2005) ("The preamble provides the only antecedent basis of 'processor system'; therefore, the preamble, including the phrase 'distributed computer system,' limits the scope of the claimed invention.")

In In re Stencel, 4 U.S.P.Q.2d 1071 (Fed. Cir. 1987), the claim at issue was directed to a driver for setting a joint of a threaded collar where the body of the claim did not directly include the structure of the collar, but rather this was recited in the preamble. The court stated:

As a matter of claim draftsmanship, appellant is not barred from describing the driver in terms of the structure imposed upon it by the collar . . . .  
The framework – the teachings of the prior art – against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims themselves are so limited.

\* \* \*

The cited references would not have taught or suggested the structure of the claimed driver in the absence of prior knowledge of Stencel's fastener system. Stencel's system is not prior art against the claims of his own patent application. Nor is obviousness established by combining the teachings of the prior art to

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produce the claimed invention, absent some teaching or suggestion that the combination be made. [Citations omitted, emphasis added].

Similarly, in this application, Applicant is entitled to describe the marker in terms of the structure imposed upon it by the structure recited in the preamble, and such limitations serve to further limit and patentably distinguish the claimed invention over the cited prior art. As in Stencel, the framework against which patentability is measured is not all markers broadly, but rather markers for identifying or measuring details of an image provided on a light transmitting substrate.

It is therefore respectfully submitted that amended independent claim 1 is not anticipated by Michelson for at least these reasons. Because claims 2, 3 and 11 each depend from, and therefore include all of the limitations of amended independent claim 1, it is respectfully submitted that these claims are not anticipated by Michelson for at least the same reasons as is claim 1, and for reciting additional patentable subject matter. In addition, it is respectfully submitted that claim 13 is not rendered obvious over Michelson for at least the reasons summarized above, and for reciting additional patentable subject matter.

Smolen does not teach or suggest an apparatus comprising a light transmitting substrate for providing an image or diagnostic image, as recited in amended independent claims 29, 32 and 33. Nor does Smolen teach or suggest a removable marker having a first portion with adhesive backing releasably attachable to the light transmitting substrate, and a second portion that is substantially transparent and without adhesive backing overlying at least a portion of the image of the substrate in an attached position such that at least a portion of the image is viewable therethrough, as further recited in amended independent claims 29, 32 and 33. Still further, Smolen does not teach or suggest any such marker having a second portion that is manually engageable and movable relative to the substrate and first portion in the attached position for viewing the image other than through the substantially transparent portion, and without lifting the adhesive backed portion from the substrate, as further recited in amended independent claim 29. Similarly, Smolen also fails to teach or suggest any such marker portion having a target sight or gauge portion thereon viewable with reference to at least a portion of the underlying image through the second portion and enabling identification or measurement of at least a portion of the underlying image, as further recited in amended independent claims 32 and 33.

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In stark contrast to the presently claimed invention, Smolen has nothing to do with markers, such as diagnostic imaging markers, for viewing underlying images on light transmitting substrates. Rather, Smolen's teachings are limited to a device for applying registration markings to superimposed sheets in order to precisely register the sheets with each other. As shown in FIGS. 4 and 5, the indicia 15 are securely affixed (not releasably engaged) to the upper sheet S' and the silhouette indicia 16' are securely affixed (not releasably engaged) to the underlying sheet S to allow the sheets to be precisely registered when one is superimposed on the other. Smolen has nothing to do with markers for viewing therethrough underlying diagnostic or other images on a light transmitting substrate as recited in amended independent claims 29, 32 and 33, and as such fails to teach any of the structural features recited in these claims as summarized above.

It is therefore respectfully submitted that claims 29 and 32-33 are not anticipated by Smolen for at least these reasons. Because claim 30 depends from, and therefore includes all of the limitations of amended independent claim 29, it is respectfully submitted that this claim is not anticipated by Smolen for at least the same reasons as claim 29, and for reciting additional patentable subject matter.

Bedford, Jr. does not teach or suggest a removable marker having a first portion including at least one substantially opaque, writable surface portion located on an opposite side of the marker relative to the adhesive backing and configured to receive writing thereon, and a second portion located laterally with respect to the first portion that is substantially transparent and overlies at least a portion of the image of the substrate in an attached position with at least a portion of the image viewable therethrough, as recited in amended independent claim 34. To the contrary, Bedford, Jr. teaches an indicating device that is entirely translucent, without any teaching or suggestion of a substantially opaque, writable surface portion, much less any such portion located laterally with respect to a substantially transparent portion, as recited in amended independent claim 34.

Similarly, Bedford, Jr. fails to teach or suggest a method comprising the steps of (i) providing a marker comprising a substrate having a first portion and a second portion, wherein the first portion has a surface with an adhesive backing and the second portion is substantially transparent and has indicia thereon; (ii) releasably engaging the first position of the marker to the substrate and positioning the second portion of the marker over at least a portion of the image

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with at least a portion of the underlying image visible therethrough; and (ii) viewing at least a portion of the underlying image through the second portion, and at least one of identifying and measuring the underlying area of interest of the image with reference to the indicia, as recited in amended independent claim 41. To the contrary, Bedford, Jr.'s teachings are limited to identification devices that are entirely translucent without any indicia thereon, and therefore Bedford, Jr. fails to teach or suggest any method involving identifying or measuring an underlying area of interest of an image with reference to any such indicia, as recited in amended independent claim 41.

With respect to amended independent claim 42, Bedford, Jr. fails to teach or suggest a marker substrate having a first portion and a second portion located laterally on the marker with respect to the first portion, wherein the first portion has means for releasably adhering the marker substrate to the light transmitting substrate in an engaged position overlying at least a portion of the diagnostic image, and the second portion has means for at least one of identifying and measuring an area of interest on the underlying diagnostic image. To the contrary, Bedford, Jr.'s teachings are limited to identification devices that are uniformly translucent without any such first and second portions laterally oriented relative to each other, let alone any such portion having the claimed means for identifying or measuring an underlying area of interest of the diagnostic image, as recited in amended independent claim 42.

It is therefore respectfully submitted that claims 34 and 41-42 are not anticipated by Bedford, Jr. for at least these reasons.

Riordan does not teach or suggest a marker for identifying or measuring details of an image provided on a light transmitting substrate on the which the marker is overlaid, much less a substrate having an adhesive backing releasably engageable with the light transmitting substrate at an engaged position overlying at least a portion of the image, as recited in amended independent claim 1. Riordan likewise fails to teach or suggest such a marker further having at least one portion located laterally on the substrate with respect to the adhesive backing that is substantially transparent, that overlies at least a portion of the image in the engaged position with at least a portion of the underlying image viewable therethrough, and that has indicia viewable with reference to at least a portion of the underlying image through the substantially transparent portion for identifying or measuring details of the underlying image, as further recited in

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amended independent claim 1. In stark contrast to the present invention as recited in amended independent claim 1, Riordan teaches a method of dispensing tabs that are fixedly secured (not releasably engaged) to the margins of paper sheets, such as the types of tabs conventionally used in paper notebooks. Riordan's tabs having nothing to do with identifying or measuring details of an image provided on a light transmitting substrate, and therefore Riordan fails to teach or suggest the structural features of the presently claimed invention as summarized above.

Accordingly, it is respectfully submitted that amended independent claim 1 is not anticipated by Riordan for at least these reasons. Because claim 40 depends from and therefore includes all of the limitations of amended independent claim 1, it is respectfully submitted that claim 40 is not anticipated by Riordan for at least the same reasons as independent claim 1, and for reciting additional patentable subject matter. In addition, it is respectfully submitted that claims 29-31 are unobvious over Riordan in view of Bedford, Jr. for at least these reasons.

Carlson II also fails to teach or suggest a marker for identifying or measuring details of an image provided on a light transmitting substrate on which the marker is overlaid, much less such a substrate having an adhesive backing releasably engageable with the light transmitting substrate at an engaged position overlying at least a portion of the image, as recited in amended independent claim 1. Carlson II also fails to teach or suggest such a marker further having at least one portion located laterally on the substrate with respect to the adhesive backing that is substantially transparent, that overlies at least a portion of the image in the engaged position with at least a portion of the underlying image viewable therethrough, and that has indicia viewable with reference to at least a portion of the underlying image through the substantially transparent portion for identifying or measuring details of the underlying image, as recited in amended independent claim 1. To the contrary, Carlson teaches a surgical site marking system that is securely fixed to a patient's skin and that includes an incise material 10 that permits a surgical procedure to be performed therethrough by cutting through the incise material with a surgical instrument. Thus, Carlson II has nothing to do with marking underlying images on a light transmitting substrate. Further, as acknowledged by the Examiner, Carlson II fails to teach or suggest any such marker having a substantially transparent portion that overlies an image such that the underlying image is viewable therethrough, much less any such substantially transparent portion located laterally on the substrate with respect to the adhesive backing, as recited in

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amended independent claim 1. To the contrary, Carlson II teaches an adhesive backing that underlies the entire device, and therefore even if it were obvious to modify Carlson II to include the claimed substantially transparent portion as suggested by the Examiner (which Applicant disputes), the resulting device still would not meet the terms of the presently claimed invention.

It is therefore respectfully submitted that amended independent claim 1 is unobvious over Carlson II for at least these reasons. Because claims 2-7, 11-12, and 14-28 each depend from amended independent claim 1, it is respectfully submitted that these claims are not obvious over Carlson II for at least the same reasons as independent claim 1, and for reciting additional patentable subject matter.

Accordingly, it is respectfully submitted that claims 1-34 and 40-46 are allowable. All issues raised by the Examiner having been addressed, an early action to that effect is earnestly solicited.

If the Examiner wishes to discuss any of the issues raised herein, or otherwise if it would facilitate the examination of this application, please call the undersigned at the telephone number below.

In the event the Commissioner of Patents and Trademarks deems an additional fee or extension to be required in connection with this paper, Applicant's attorney hereby authorizes that such fee be charged to Deposit Account No. 50-3569, and if an additional extension is required, please consider this to be a petition therefor.

Respectfully submitted,

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